

REMARKS

This responds to the Office Action mailed on August 19, 2005. By this amendment, no claims are amended, canceled, or added. As a result, claims 1-14 remain pending in this application. Reconsideration of the application is requested in view of the following remarks.

§102 Rejection of the Claims

Rejection: Claims 1-8 and 14 were rejected under 35 U.S.C. § 102(b) for anticipation by U.S. Patent No. 5,867,963 to Hershey.

Response: Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Claim 1 recites “...each said inclined branch of said connector members being formed of at least two planks each having a rectangular cross-section consisting of opposite side faces and opposite side edges and having adjacent side edges adhesively joined to one another...” (Underlining added for emphasis). The Hershey reference does not meet the recitations of claim 1. Specifically, the Hershey reference does not teach each and every element of the claimed invention, arranged as in the claim. Although Hershey does seem to teach the that two member diagonally extending struts or web members it does not show the arrangement. (See column 3, lines 7-14). There is no teaching of the specific arrangement of the planks, and there is also no teaching of having adjacent side edges of the planks adhesively joined to one another, as required

by Claim 1. Therefore, there is no anticipation since Hershey fails teach each and every element of the claimed invention arranged as in the claim.

In addition, claim 1 recites "...wherein each plank of a V-shaped structural element is joined at said lower chord to form a single connection therewith and two connections to said upper chord..." (emphasis added) The Hershey reference also falls short of this recitation in claim 1. Hershey discloses web members 28 "...each of which are connected at their respective ends to the respective upper and lower chords 22, 24." (See column 3, lines 8-13 of the Hershey reference). Thus, each web member of Hershey is connected to both the lower and upper cords, the V-shaped structural elements of Hershey consist of two connections to the lower cord and two connections to the upper cord. Hershey, therefore, teaches four connections, rather than the single connection therewith and two connections to said upper chord recited in claim 1. Once again, Hershey falls short of anticipating claim 1 since Hershey fails to teach each and every element of the claimed invention arranged as in the claim. The Examiner has also failed to make out a *prima facie* case of anticipation since Hershey fails teach each and every element of the claimed invention arranged as in the claim. As a result of the above, claim 1 now overcomes the Examiner's rejection under 35 U.S.C. § 102(b) for anticipation by Hershey (U.S. Patent No. 5,867,963).

Claims 2-8 depend from claim 1 and include the recitations of claim 1 by their dependency. As a result, claims 2-8 also overcome the Examiner's rejection under 35 U.S.C. § 102(b) for anticipation by Hershey (U.S. Patent No. 5,867,963).

Claim 14 recites "...each connector member comprising a first plank and a second plank, the first plank having a first side, a first end, and a second end, second plank having a second side, a third end and a fourth end, the first side being adhesively secured to the second side, the first and third ends being adhesively secured to the first chord, and the second and fourth ends being adhesively secured to second chord." The Hershey reference does not meet the recitations of claim 14. Specifically, the Hershey reference does not teach each and every element of the claimed invention, arranged as in the claim. Although Hershey does seem to teach the that two member diagonally extending struts or web members it does not show the arrangement. (See column 3, lines 7-14). There is no teaching in Hershey of the specific arrangement of the planks,

and there is also no teaching of having the first side of the first plank being adhesively secured to the second side of the second plank, as required by Claim 14. In addition, there is no teaching in Hershey of the first and third ends being adhesively secured to the first chord, and the second and fourth ends being adhesively secured to second chord, as required by claim 14. As a result, the Examiner fails to make out a *prima facie* case of anticipation since Hershey fails teach each and every element of the claimed invention arranged as in the claim. As a result, claim 14 now overcomes the Examiner's rejection under 35 U.S.C. § 102(b) for anticipation by Hershey (U.S. Patent No. 5,867,963).

§103 Rejection of the Claims

Rejection: Claims 9-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,867,963 to Hershey.

Response: In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claims 9-13 depend, either directly or indirectly, from claim 1. Claims 9-13 also include the recitations of claim 1 by their dependency. The Examiner has failed to make out a proper *prima facie* case of obviousness since the Hershey reference fails to teach or suggest all the claim limitations. As discussed above, there is no teaching or suggestion of the specific arrangement of the planks, or having adjacent side edges of the planks adhesively joined to one another, as required by Claim 1. In addition, the Hershey reference also fails to teach or suggest that each plank of a V-shaped structural element is joined at said lower chord to form a single connection

therewith and two connections to said upper chord. Each web member of Hershey is connected to both the lower and upper cords, and the V-shaped structural elements of Hershey consist of two connections to the lower cord and two connections to the upper cord. Hershey, therefore, teaches and suggests four connections, rather than the single connection therewith and two connections to said upper chord recited in claim 1. As a result, the Examiner has failed to make out a *prima facie* case of obviousness since Hershey fails to teach or suggest each and every element of the claimed invention. As a result of the above, claim 1 now overcomes the Examiner's rejection under 35 U.S.C. § 103(a) for obviousness by Hershey (U.S. Patent No. 5,867,963).

In addition, the Examiner rejected claims 9-13 based solely on the Hershey reference. Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in the Hershey reference. Since all the elements of the claim are not found in the Hershey reference, Applicant requests that the Examiner cite a reference that includes the missing elements. In the alternative, Applicant requests that the Examiner place an affidavit of personal knowledge in the file for any elements the Examiner contends are commonly used arrangement in the industry. Still another alternative is that the Examiner indicates any taking official notice of the missing elements. Applicant respectfully objects to the reason set forth for obviousness set forth in the Office Action of August 19, 2005 or to any taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of February, 2006.

PATRICIA A. HULTMAN

Name


Signature